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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,975	03/23/2001	Jayme Matthew Fishman	13230-101	7347

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EXAMINER	
JACKSON, JENISE E	
ART UNIT	**PAPER NUMBER**
2131	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/816,975	FISHMAN ET AL.	
	Examiner	Art Unit	
	Jenise E Jackson	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the c rresp ndence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *6/10/2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Final Action

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, 10-17 rejected under 35 U.S.C. 102(b) as being anticipated by Maes.

3. As per claim 1, Maes et al. discloses a system for authentication of a party in a transaction conducted over a communication network(see col. 7, lines 57-65), a wallet-sized storage medium(i.e. smartcard)(see col. 14, lines 21-22) containing information uniquely associated with the party read by a ordinary computer operated by the party at the time of the transaction; and an authentication server remote from the computer that receives the stored information(i.e. digital signature) and a personal code(i.e. PIN) entered by the party(see col. 8, lines 25-27) from the conventional computer as part of the transaction and authenticates the party to the transaction upon matching of the stored information with information in a preexisting database of the server based on the personal code(see col. 14, lines 17-46).

4. As per claim 2, Maes et al. discloses wherein the stored information is transmitted from the conventional computer to the authentication server via a computer of a second party(i.e. ATM or POS terminal)(see col. 14, lines 17-45).

5. As per claim 3, Maes et al. discloses wherein the personal code is transmitted from the conventional computer to the authentication server via the computer of the second party(see col. 14, lines 21-26).

6. As per claim 4, wherein the stored information are one-use tokens(col. 11, lines 17-26).

7. As per claim 5, Maes et al. discloses wherein the stored information is a digital certificate(see col. 14, lines 21-24).

8. As per claim 6, Maes et al. discloses wherein the personal information is a password(see col. 14, lines 21-24).

9. As per claim 7, Maes et al. discloses wherein the wallet-sized storage medium is a truncated CD(i.e. smartcard)(see col. 14, lines 22).

10. As per claim 10, Maes et al. discloses copying to a document generated by the application information from a wallet-sized storage medium read by the conventional, the copied information uniquely associated with a user interacting with the application(see col. 3, lines 17-37). Further, as per claim 10, limitations have already been addressed(see claim 1).

11. As per claim 11, limitations have already been addressed(see claim 1).

12. As per claim 12, limitations have already been addressed(see claim 2).

13. As per claim 13, limitations have already been addressed(see claim 3).

14. As per claim 14, limitations have already been addressed(see claim 4).

15. As per claim 15, limitations have already been addressed(see claim 5).

16. As per claim 16, limitations have already been addressed(see claim 6).

17. As per claim 17, limitations have already been addressed(see claim 7).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maes et al. in view of Lambert et al.

20. As per claim 8, Maes does not disclose wherein the stored information includes at least two groups, each of which, upon matching the personal code by the authentication server, authenticates the transaction for a different level of security or authority than authentication thorough the second group; Lambert however discloses wherein the stored information includes at least two groups, each of which, upon matching the personal code by the authentication server, authenticates the transaction for a different level of security or authority than authentication thorough the second group(see col. 2, lines 2-13, 30-33).

21. It would have been obvious to one of ordinary skill in the art to combine Maes with Lambert, because Lambert discloses that problem arises when seeking to control access to data where a number of different users are required to be allowed to access different sets of data such as an ATM(see col. 1, lines 11-21, 48-50). Lambert discloses that a conventional approach to this problem included having a table lookup process of the user, however, Lambert discloses that lookup tables are vulnerable to breaches of security(see col. 1, lines 58-67 of Lambert), thus in Lambert's system the lookup data is stored on the smart card.

22. As per claim 9, Lambert discloses wherein the user has at least two personal codes that may be matched to the stored information, each of which, upon matching with the personal code by the authentication server, authenticates the transaction for a different level of security or authority than authentication thorough the second personal code(see col. 2, lines 2-13, 30-33). Also, as per claim 9, same motivation applies(see claim 8).

23. As per claim 18, limitations have already been addressed(see claim 8).

24. As per claim 19, limitations have already been addressed(see claim 9).

Double Patenting

25. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

26. Claims 1-3 and 11 of 09/816975 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, and 9 of copending Application No. 10/132438. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

27. As per claim 1 of 09/816975, and claim 1 of 10/132438, 10/132438 claims the storage medium integrally including additional information uniquely associated with the party. It would have been obvious to include this limitation in 09/816975 the motivation is that the storage medium can include additional information such as the stored information and personal code of the party, because the storage medium is used in order to perform a transaction, and thus the party is authenticated based on this information. Further, as per claim 1 of 09/816975 and 10/132438 recite same limitations.

28. As per claim 2, of 09/816975, and claim 2 of 10/132438 recite same limitations.

29. As per claim 3, of 09/816975, and claim 2 of 10/132438 recite same limitations.

30. As per claim 11, of 09/816975, and claim 11 of 10/132438, 10/132438 claims storage medium integrally including additional information uniquely associated with the party, 09/816975 claims prompting for and receiving entry by the conventional computer of personal code of the party. It would have been obvious to include the limitation above(10/132438), because the storage medium is used in order to perform a transaction, and thus the party is authenticated based on this information.

Response to Amendment

31. The Applicant states that Maes discloses the authentication for access to card information is performed at the transaction location using only local information; and also, the Applicant states that Maes does not provide a mechanism for providing a decryption key. The Applicant seems to be arguing limitations, which are not claimed. Therefore, this argument is moot.

32. Second, the Applicant states that the claims have been amended to emphasize an ordinary computer. This is not overcome by the art that was applied to the claims. The PDA device of

Maes is an ordinary computer. If the Applicant wishes to have a more specific term of ordinary computer that it must be claimed. Otherwise, the Examiner is to interpret the claims broadly in light of the specification. The wallet sized storage medium of Maes is a smartcard, which contains information that is read by the central server(see col. 14, lines 21-22, col. 7, lines 66-67, col. 8, lines 1-5).

33. The Applicant states that Maes discloses access rather than authentication. The Examiner disagrees with the Applicant. Maes discloses authentication, because communication between the pda device(10) and the central server(60) can be established(see col. 7, lines 66-67, col. 8, lines 1-5). Once communication is established the user is prompted to enter verification data, and this data is transmitted to the central server(see col. 8, lines 13-65). The Applicant states that the instant invention does authentication by a third party. Maes does authentication by third party, the central server does the authentication(see col. 8, lines 13-65).

34. The Applicant states that Maes does not disclose a system for authentication of a party in a transaction conducted over a communication network(already addressed see above).

35. The Applicant states that Maes does not disclose receipt by a remote authentication server of the information stored on the storage media to be matched at the server. The Examiner disagrees with the Applicant. The smart card has digital certificate, biometric, and pin information stored on the smart card. This is inserted into the kiosk and verified to determine whether this information is valid (see col. 14, lines 17-30).

36. The Applicant states that there is no first computer. The Examiner disagrees with the Applicant. The first computer is the pda device of Maes(see col. 3, lines 17-22).

37. The Applicant states that Maes does not disclose one-use tokens. The Examiner disagrees with the Applicant. If the digital certificate on the card is not valid, the card cannot be used(see col. 11, lines 17-26).

38. The Applicant states that Maes does not disclose a digital certificate that is read by an ordinary computer and received by a remote server for matching based on a personal code. The Examiner disagrees with the Applicant. The ATM, or Kiosk, or POS terminal, can verify the information, the digital certificate, and determine whether it is valid(see col. 14, lines 17-35).

39. The Applicant states that Maes does not disclose a password entered by the user at the ordinary computer. The Examiner disagrees with the Applicant. Maes discloses that the user may enter the Pin through the display(see col. 8, lines 40-42).

40. The Applicant states that Maes does not disclose a truncated CD with stored information read by the computer. The Examiner disagrees with the Applicant. Maes discloses a truncated CD, because Maes discloses a smart card(see col., 14, line 22). If the Applicant wishes to have a more specific term of truncated cd than it must be claimed. Otherwise, the Examiner is to interpret the claims broadly in light of the specification.

41. The Applicant states that Maes does not disclose a computer program module for insertion in a document generated on a computer. The Examiner disagrees with the Applicant. Maes discloses a universal card which information can be downloaded from the central server(see col. 3, lines 27-52).

42. The Applicant states that Maes does not disclose reading information from a storage medium. The Examiner disagrees with the Applicant(see col. 3, lines 45-52).

43. The Applicant states that Maes does not disclose reading a one-use token from a storage medium by an ordinary computer and transmitting that information through a second computer to the authentication server. The Examiner disagrees with the Applicant (see col. 11, lines 17-26).

44. In response to applicant's arguments against the references individually of Maes in view of Lambert, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

45. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lambert discloses that problem arises when seeking to control access to data where a number of different users are required to be allowed to access different sets of data such as an ATM(see col. 1, lines 11-21, 48-50). Lambert discloses that by having a lookup table are vulnerable to breaches of security, thus the lookup data is stored on the smart card.

46. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (703) 306-0426. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 9, 2005